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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/412,969	10/05/1999	JENNIE CHING	BC9-99-024	1335

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EXAMINER
CHUNG, JASON J

ART UNIT	PAPER NUMBER
2611	

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/412,969	CHING ET AL.
	Examiner	Art Unit
	Jason J. Chung	2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *08 October 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: . .

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because the specification contains two paragraphs. The specification should be one paragraph. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12, 19, 22, 24-27, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 12, there is no antecedence for method in claim 10. It appears claim 12 depends on claim 11 where there is antecedence for the method. Examiner considers claim 12 to depend on claim 11. Appropriate correction is required.

Regarding claim 19, there is no antecedence for programming instruction in claim 15. It appears claim 19 depends on claim 18 where there is antecedence for the programming instruction. The method in claim 18 should be a computer readable medium because there is no antecedence for method in claim 18 as the corresponding claim 2 depends on claim 1. Examiner considers claim 19 to depend on claim 18 and the method to be a computer readable medium. Appropriate correction is required.

Regarding claim 22, claim 22 should depend on claim 18 as the corresponding claim 5 depends on claim 1. Examiner considers claim 22 to depend on claim 18. Appropriate correction is required.

Regarding claim 24, claim 24 should depend on claim 18 as the corresponding claim 7 depends on claim 1. Examiner considers claim 24 to depend on claim 18. Appropriate correction is required.

Regarding claim 25, claim 25 should depend on claim 18 as the corresponding claim 8 depends on claim 1. Examiner considers claim 25 to depend on claim 18. Appropriate correction is required.

Regarding claim 26, claim 26 should depend on claim 18 as the corresponding claim 9 depends on claim 1. Examiner considers claim 26 to depend on claim 18. Appropriate correction is required.

Regarding claim 27, there is no antecedence for programming instruction in claim 15. It appears claim 27 depends on claim 18 where there is antecedence for the programming instruction. Examiner considers claim 27 to depend on claim 18. Appropriate correction is required.

Regarding claim 29, there is no antecedence for apparatus in claim 24 or any other claim. The scope of the claim is indeterminable. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-5, 8-16, 18-22, 25-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Seidman.

Regarding claim 1, Seidman discloses a method of upstream and downstream communication (column 4, lines 30-35), which is the same as a method for transmitting and receiving. Seidman discloses a user selecting program segments to be played (column 10, lines 7-8), which inherently comprises of a play list which is the same as receiving a play-list, wherein the play-list is a list of instructions for the rendering of the multimedia segments into a multimedia presentation. Seidman discloses receiving program segments (column 4, line 64-column 5, line 2), which is the same as multimedia segments required by the play-list. Seidman discloses that there is no display overlap when the user selects the play-list comprising of the program segments (column 10, lines 7-9), which inherently comprises a display, which is the same as receiving the multimedia presentation on the display by rendering the multimedia segments as directed by the play-list.

Regarding claim 2, Seidman discloses a method wherein a set top-box, which receives multimedia broadcasts (column 6, lines 10-12). The set-top box connects to a computer and the computer stores and retrieves large files. The previously described method is the same as the viewer information processing system receiving at least one multimedia segment prior to the presentation being displayed, and stores at least one multimedia segment.

Regarding claims 3 and 5, Seidman discloses receiving the multimedia segments at least one multimedia segment over a cable TV infrastructure (column 10, lines 41-43), which is the same as a broadcast infrastructure or a telecommunications network.

Regarding claim 4, Seidman discloses a method of retrieving a multimedia segment from a computer storage medium (column 6, lines 10-12), which is the same as receiving at least one multimedia segment from a computer readable storage medium.

Regarding claim 8, Seidman discloses a method of receiving commercials 74 (figure 6), which is the same as receiving at least one advertisement.

Regarding claim 9, Seidman discloses a method of receiving program segments, which are sections of media streams (column 4, lines 64-66), which is the same as receiving at program content.

Regarding claim 10, Seidman discloses a method of receiving a play-list based on the demographics of the viewers of the multimedia presentation (column 6, lines 2-8).

Regarding claim 11, the limitations on claim 11 have been covered in claim 1 rejection. Additionally, Seidman discloses media streams being sectioned into program segments (column 4, line 64-column 5, line 2), which is the same as breaking program content into a plurality of multimedia segments.

Regarding claim 12, Seidman discloses a selection history record recording the object selected and whether the user stored the related information (column 7, lines 47-53), which is the same as the program provider transmitting at least one multimedia segment to at least one client prior to the multimedia presentation by the client.

Regarding claim 13, Seidman discloses assembling demographic information on viewers in order to customize program content (column 6, lines 2-8), which is the same as grouping viewers based on demographics of the viewers of the multimedia presentation, which inherently transmits the identical play-list to one or more clients based on the grouping.

Regarding claim 14, method of claim 11 for distributing program content, wherein the step of transmitting multimedia segments includes transmitting at least one multimedia segment on a computer readable storage medium.

Regarding claim 15, the limitations on claim 15 have been covered in claim 3 rejection.

Regarding claim 16, the limitations on claim 16 have been covered in claim 5 rejection.

Regarding claims 18-22 and 25-27, the limitations on claims 18-22 and 25-27 have been covered in claims 1-5 and 8-10 rejections respectively. Additionally, claims 1-5 and 8-10 are methods, whereas claims 18-22 and 25-27 are computer readable mediums. Seidman discloses a microcontroller 9 (figure 1) on a set-top box that connects to a computer (column 6, line 23-25), which is the same as a computer readable medium. The microcontroller performs the methods stated in claims 1-10.

Regarding claim 28, Seidman discloses an infrared interface 10 (figure 1) for users to input selections, which is also a receiver for receiving a play-list. Seidman discloses an input port 2 (figure 1), which is also receiver for receiving the multimedia segments. Seidman

discloses a tuner 3 (figure 1), which is also a means for rendering multimedia segments. Seidman discloses an audio decoder 6 and a video decoder 7, which interfaces to a display because it is a set-top box.

Regarding claim 30, the limitations on claim 30 have been covered in claim 3 rejection. Additionally, claim 30 is a viewer information processing system, whereas claim 3 is a method. Seidman discloses a set-top box 1 (figure 1), which is the viewer information processing system that performs the methods in claim 3.

Regarding claim 31, the limitations on claim 31 have been covered in claim 4 rejection. Additionally, claim 31 is a viewer information processing system, whereas claim 4 is a method. Seidman discloses a set-top box 1 (figure 1), which is the viewer information processing system that performs the methods in claim 4.

Regarding claim 32, the limitations on claim 32 have been covered in claim 5 rejection. Additionally, claim 32 is a viewer information processing system, whereas claim 5 is a method. Seidman discloses a set-top box 1 (figure 1), which is the viewer information processing system that performs the methods in claim 5.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 6, 7, 17, 23, 24, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seidman.

Regarding claim 6, Seidman fails to disclose a method for receiving at least one multimedia segment over the Internet. The examiner takes Official Notice that receiving multimedia content over the Internet is notoriously well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Seidman to change the telecommunications network from a cable TV infrastructure into Internet in order to transmit information farther distances.

Regarding claim 7, Seidman discloses interactive television (column 3, lines 11-15). Seidman discloses a video display (column 5, line28). Seidman fails disclose the display being a television set. The examiner takes Official Notice that using television sets as displays is notoriously well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Seidman to display the multimedia segments on a television set in order to have display a clearer picture by utilizing high definition televisions.

Regarding claim 17, the limitations on claim 17 have been covered in claim 6 rejection.

Regarding claim 23, the limitations on claim 23 have been covered in claim 6 rejection. Additionally, claim 6 is a method, whereas claim 23 is a computer readable medium, which performs the method stated in claim 6.

Regarding claim 24, the limitations on claim 24 have been covered in claim 7 rejection. Additionally, claim 7 is a method, whereas claim 24 is a computer readable medium, which performs the method stated in claim 7.

Regarding claim 33, the limitations on claim 33 have been covered in claim 6 rejection. Additionally, claim 33 is a viewer information processing system, whereas claim 6 is a method. Seidman discloses a set-top box 1 (figure 1), which is the viewer information processing system that performs the methods in claim 6.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Katinsky discloses play-lists for playing media objects, advertisements with the programming, and broadcasting based on demographics in US Patent # 6,452,609. Viswanathan discloses broadcasting segments of movies in US Patent # 5,936,659. Biliris discloses sending different multimedia programs on a server in US Patent # 5,720,037. Duso discloses using a play-list to play multimedia clips in US Patent # 5,892,915. DuLac discloses movie on demand where the user can jump to any section of the movie in US Patent # 5,899,582. Hendricks discloses sending program lineups for video on demand or near video on demand in US Patent # 5,600,573. Dwek discloses play-lists for playing music on a media player with advertisements in US Patent # 6,248,946. Esch discloses customizing advertising and generating a plurality of content signals in US Patent # 5,099,319.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason J. Chung whose telephone number is (703) 305-7362. The examiner can normally be reached on M-F, 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew I. Faile can be reached on (703) 305-4380. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 308-6606 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9700.

JJC
October 21, 2002

ANDREW FAILE
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